

ESTTA Tracking number: **ESTTA624862**

Filing date: **09/03/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	ASCENSION HEALTH ALLIANCE
Granted to Date of previous extension	09/03/2014
Address	101 S. HANLEY ROAD, SUITE 450 ST. LOUIS, MO 63105 UNITED STATES
Attorney information	Jonathan E. Moskin Foley & Lardner LLP 3000 K Street, N.W., Suite 600 Washington, DC 20007-5109 UNITED STATES IPdocketing@foley.com, jmoskin@foley.com, ygorbach@foley.com, sschoepfer@foley.com Phone:212.338.3572

### Applicant Information

Application No	85702989	Publication date	05/06/2014
Opposition Filing Date	09/03/2014	Opposition Period Ends	09/03/2014
Applicant	Ascension Insurance, Inc. 2345 Grand Blvd., Suite 610 Kansas City, MO 64108 UNITED STATES		


### Goods/Services Affected by Opposition

<p>Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Insurance claims auditing services; insurance lead collection and matching services, namely, matching consumer requests for insurance policy quotes collected over the internet to pre-qualified insurance brokers, agents and agencies interested in those requests; promotion of financial and insurance services, on behalf of third parties; providing insurance agent referrals</p>
<p>Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Advisory services in the field of employee benefits for group healthcare and business insurance offered to employees in addition to standard benefits such as medical, dental, life insurance including short-term disability, long-term disability and accidental death and dismemberment; agricultural insurance agency services; brokerage in the field of insurance; claims administration in the field of workers compensation; claims administration in the field of health insurance; financial evaluation for insurance purposes; insurance administration; insurance agencies; insurance agency and brokerage; insurance brokerage; insurance claims administration; insurance consultation; insurance services, namely, writing property and casualty insurance; providing information in insurance matters; processing, administering and managing employee benefit plans concerning insurance and finance</p>


## Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

## Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2478534	Application Date	09/23/1999
Registration Date	08/14/2001	Foreign Priority Date	NONE
Word Mark	ASCENSION HEALTH		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 1999/09/29 First Use In Commerce: 1999/09/29 [FITNESS CENTERS]</p> <p>Class 042. First use: First Use: 1999/09/29 First Use In Commerce: 1999/09/29 HEALTHCARE SERVICES, NAMELY, PROVIDING HEALTHCARE FACILITIES IN THE NATURE OF HOSPITALS, LONG-TERM CARE FACILITIES, CLINICS, WELLNESS CENTERS, CONGREGATE AND ASSISTED LIVING FACILITIES AND OTHER HEALTHCARE FACILITIES, PROVIDING SERVICES IN THE NATURE OF HOME HEALTH CARE AGENCIES, HOSPICE AGENCIES, MANAGED CARE ORGANIZATIONS, PHYSICIAN AND HOSPITAL ORGANIZATIONS, MANAGED SERVICES ORGANIZATIONS, HEALTH NETWORKS, HEALTH MAINTENANCE ORGANIZATION, AND PREFERRED PROVIDER ORGANIZATIONS, AND PROVIDING OCCUPATIONAL AND PHYSICAL THERAPY AND REHABILITATION SERVICES, PHARMACY SERVICES, DRUG SCREENING, PHYSICAL EXAMINATIONS, NURSING SERVICES, LABORATORY SERVICES, OUTPATIENT SERVICES, FITNESS CENTERS FOR THERAPEUTIC USE, WOMEN'S SERVICES CENTERS, SURGERY SERVICES, SENIOR'S SERVICES, DIABETES DIAGNOSTIC AND TREATMENT SERVICES, ONCOLOGY DIAGNOSTIC AND TREATMENT SERVICES, WOUND CARE, AND EMERGENCY MEDICAL SERVICES</p>		

U.S. Registration No.	4069046	Application Date	03/04/2010
Registration Date	12/13/2011	Foreign Priority Date	NONE
Word Mark	ASCENSION HEALTH		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 035. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00  Management and operation of a health system comprised of hospitals, medical clinics, nursing homes, acute care facilities, long-term care facilities, wellness centers, congregate and assisted living facilities, outpatient surgery centers, urgent care centers, imaging centers, cancer centers, rehabilitation centers, pharmacies, health and physical therapy centers, convalescent centers, heart centers, home healthcare, and hospice care centers; association services, namely, promoting the interests of medical patients and access to and growth of the healthcare industry; promoting public awareness of the transformation of healthcare, access to healthcare coverage for all, healthcare reform, health, disease prevention, health care cost containment, chronic disease management, health care, health care policy, and health care management</p> <p>Class 036. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00  Providing grants for health awareness projects; providing recognition and incentives by way of grants and other financial support in the field of healthcare; providing recognition and incentives by way of grants and other financial support to promote and encourage the provision of high quality health care to the indigent, the furtherance of patient safety programs, and the furtherance of medical research</p> <p>Class 042. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00  Providing temporary use of web-based software applications for use in monitoring medical patient safety and patient and medical event recording, tracking and reporting, namely, monitoring patient heart rates, patient falls, facilities, and clinician response times; providing temporary use of web-based software application for use in monitoring medical patient safety, medical personnel, and medical facilities</p> <p>Class 044. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00  Healthcare services, namely, providing information in the field of healthcare ethics</p>

U.S. Registration No.	4422262	Application Date	12/23/2010
Registration Date	10/22/2013	Foreign Priority Date	NONE
Word Mark	ASCENSION HEALTH SMARTHEALTH		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2011/01/11 First Use In Commerce: 2011/01/11 Services in the field of group healthcare and medical insurance benefits for employees, namely, providing insurance coverage services, namely, insurance underwriting in the field of health and insurance administration

U.S. Registration No.	4234598	Application Date	01/13/2011
Registration Date	10/30/2012	Foreign Priority Date	NONE
Word Mark	CERTITUDE BY ASCENSION HEALTH		
Design Mark			
Description of Mark	The mark consists of a stylized plus sign in fuchsia to the left of the word-ing"CERTITUDE by ASCENSION HEALTH" in darkpurple/blue.		
Goods/Services	Class 036. First use: First Use: 2011/01/01 First Use In Commerce: 2011/01/01 Professional liability insurance services, namely, insurance underwriting in the field of professional liability, administration, carrier selection, claims adjustment, claims management, namely, insurance claims administration, claims processing, consultation services, rating services, and collection; insurance underwriting in the field of professional liability; insurance administration; insurance placement, namely, providing insurance for physicians and related medical professionals, namely, providing insurance brokerage services; insurance claims		

	administration services; insurance risk/loss prevention services, namely, insurance risk management services and insurance loss control management services
--	---

Related Proceedings	92058897
---------------------	----------

Attachments	75806856#TMSN.png( bytes ) 77950779#TMSN.png( bytes ) 85204970#TMSN.png( bytes ) 85217123#TMSN.png( bytes ) Notice of Opposition to ASCENSION BENEFITS & INSURANCE SOLUTIONS, Serial No. 85702989.pdf(16452 bytes )
-------------	--

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jonathan E. Moskin/
Name	Jonathan E. Moskin
Date	09/03/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 85/702,989  
Mark: ASCENSION BENEFITS & INSURANCE SOLUTIONS

-----	X	
ASCENSION HEALTH ALLIANCE,	:	
	:	
Opposer,	:	
	:	Opposition No. _____
-against-	:	
	:	<b>NOTICE OF OPPOSITION</b>
ASCENSION INSURANCE, INC.,	:	
	:	
Applicant.	:	
-----	X	

TO THE COMMISSION FOR TRADEMARKS:

Opposer, Ascension Health Alliance, believes it will be damaged by the Application No. 85/702,989 for the Mark ASCENSION BENEFITS & INSURANCE SOLUTIONS, and having extended its time to oppose until September 3, 2014, hereby opposes the same pursuant to Section 13 of the Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1063.

As grounds for opposition, Opposer alleges that:

1. Opposer Ascension Health Alliance ("Ascension") is a nonprofit corporation duly organized and existing under the laws of the State of Missouri, with its executive offices at 101 S. Hanley Road, Suite 450, St. Louis, Missouri 63105.
2. Applicant Ascension Insurance, Inc. ("Applicant") is, upon information and belief, a company duly organized and existing under the laws of the State of Delaware, with its principal place of business at 2345 Grand Blvd., Suite 610, Kansas City, Missouri 64108.
3. Ascension is the country's largest Catholic and non-profit health system and is the third-largest system overall in the United States, based on revenues.

4. Ascension operates 113 wholly-owned and 18 additional jointly owned hospitals in 24 states and the District of Columbia. It employs more than 150,000 associates serving in more than 1,900 locations.

5. Ascension's core services include managed care organizations, health maintenance organizations, preferred provider organizations, insurance services and numerous other financial services.

6. Ascension, directly and through its wholly owned subsidiaries, also provides general liability and professional liability insurance services to its members and affiliates and health insurance services to the general market under the trademark and trade name ASCENSION.

7. Ascension is the sole owner of several trademark registrations and applications covering the mark ASCENSION, alone, in composite form and in stylized form ("ASCENSION Marks") for use with a wide range of health care services, as well as related financial and insurance services.

8. Ascension's ASCENSION Marks include valid, unrevoked and uncanceled registrations for ASCENSION HEALTH & Design (Reg. No. 2,478,534, issued August 14, 2001 and already incontestable); ASCENSION HEALTH (Reg. No. 4,069,046, issued December 13, 2011); ASCENSION HEALTH SMARTHEALTH (Reg. No. 4,422,262, issued October 22, 2013); and CERTITUDE BY ASCENSION HEALTH (Reg. No. 4,234,598, issued October 30 2012).

9. Since 1999 Ascension has continuously used its ASCENSION name and marks in connection with health care and related financial services including PPO and HMO insurance services.

10. In addition, since at least 2000 Ascension has provided general liability and professional liability insurance services under the trademark and trade name ASCENSION.

11. As a result of Ascension's long and successful use of the name ASCENSION and the ASCENSION Marks, consumers have come to recognize the name ASCENSION and Ascension's health care and related financial and insurance services offered under the name ASCENSION and the ASCENSION Marks as identifying Ascension as the sole source of the name ASCENSION and the ASCENSION Marks, and as distinguishing them from the health care and related financial and insurance services offered by other providers.

12. As a result of Ascension's great success in marketing health care and insurance services under the name ASCENSION, Ascension's name and mark has become sufficiently well-recognized to be deemed a famous mark.

13. On or about August 14, 2012, Applicant filed Application Serial No. 85/702,989 for the mark ASCENSION BENEFITS & INSURANCE SOLUTIONS for a range of insurance brokerage and advisory services in International Classes 35 and 36.

14. Among these services, Applicant offers health care, student health care and malpractice coverage for health care professionals, which compete with Opposer's services.

15. Ascension has been, and will continue to be, damaged by the registration sought by Applicant because such registration will provide Applicant with at least prima facie evidence of its exclusive right to use the subject mark. Such evidence will support and assist Applicant in the confusing and misleading use of the subject mark, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Ascension.

16. Application Serial No. 85/702,989 should be refused registration pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Applicant's use of the



subject mark falsely suggests a connection between Applicant and Ascension, to the damage of Ascension.

17. Application Serial No. 85/702,989 should be refused registration pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that the dominant portion of Applicant's subject mark so resembles the dominant portion of the ASCENSION Marks and the ASCENSION name used consistently by Ascension in the United States, as to be likely, when used in connection with the services specified in the application, to cause confusion, or to cause mistake, or to deceive, with consequent injury to Ascension and to the public.

18. Application Serial No. 85/702,989 should be refused registration under Sections 2 and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052 and 1125(c), on the grounds that Applicant's use of the subject mark will dilute the distinctive and famous quality of Ascension's ASCENSION Marks.

WHEREFORE, Ascension respectfully requests that this Notice of Opposition be sustained and that Application Serial No. 85/702,989 be refused registration.

The required fee of \$300 per Class is being submitted herewith. Please charge any additional costs to our Deposit Account No. 19-0741. All communication should be addressed to Opposer's counsel, Foley & Lardner LLP, at the below stated address.

Dated: New York, New York  
September 3, 2014

Respectfully submitted,  
  
FOLEY & LARDNER LLP

By: /s/ Jonathan E. Moskin/  
Jonathan E. Moskin, Esq.  
Janina Gorbach, Esq.  
90 Park Avenue  
New York, NY 10016-1314  
Tel.: (212) 338-3572  
Fax: (212) 687-2329

*Attorneys for Opposer*  
Ascension Health Alliance

**CERTIFICATE OF SERVICE**

I hereby certify that on September 3, 2014 a true and complete copy of the foregoing **NOTICE OF OPPOSITION** was served by first-class mail to the counsel of Applicant as follows:

Jeffrey Kass  
Polsinelli PC  
1515 Wynkoop Street, Suite 600  
Denver, CO 80202

/s/ Jonathan E. Moskin  
Jonathan E. Moskin, Esq.